1.   Summary of Office Action

In the Office Action mailed August 26, 2004, the Examiner rejected claims 1-9,

14-18, and 21-24 under 35 U.S.C. § 103(a) as being obvious over a combination of U.S.

Patent No. 6,345,095 (Yamartino) and U.S. Patent No. 6,292,557 (Gabara).

2.   The Claimed Invention

Pending in this application are claims 1-9, 14-18, and 21-24, of which claims 1, 5,

15, 21, 22, and 24 are independent and the remainder are dependent.

Applicant's invention, as recited in various ways in the pending claims, is directed

to a method and apparatus for abbreviated dialing. Generally speaking, the invention

includes the functions of (i) receiving digits entered by the user, (ii) determining whether

the digits entered by the user represent an incomplete set of digits, and (iii) if the

determination is that the sequence of digits does not match digits at the end of any

telephone number defined in the phone book, adding (e.g., pre-pending) to the sequence

of digits a predefined set of digits, so as to produce a composite number that can be used

to initiate a call. All claims except claim 24 further recite initiating a call to the

composite number.

Notice that the claimed invention thus provides for taking an action that depends

on whether it is determined that the user-entered digits match the end of any telephone

number stored in the phone book. In particular, if it is determined that the user-entered

digits do not match the end of any number stored in the phone book, then a stored set of

digits is automatically pre-pended to the entered digits so as to produce a composite

telephone number that is then used to initiate a call. (On the other hand, if it is

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determined that the user-entered digits do in fact match the end of some number in the phone book, then that number can be used to initiate a call.)

This arrangement conveniently allows a user to simply enter any abbreviated set of digits that does not match the end of any number in the phone book, and to have the system automatically convert that abbreviated set of digits into a full telephone number by pre-pending the stored set of digits. As a practical example of this, assume the phone numbers at a user's place of business all begin with the area code and prefix 913-890, and assume the user's phone book contains just the numbers 913-890-1234, 913-890-4567, and 312-432-9876. Assume further that one of the use's colleagues at work has the extension 5656. With the benefit of the present invention, the user could then simply enter the digits 5656 (for example) and, after the system determines that the digit sequence 5656 does not match the end of any number stored in the user's phone book, the system can automatically pre-pend the digits 913-890 to the entered digits 5656, so as to produce the composite number 913-890-5656. The system can then initiate a call to that composite number.

The invention thereby provides an enhanced abbreviated dialing function that does not require the entered digits to match the end of a number in the phone book, and in fact requires the entered digits to not match the end of any number in the phone book – in order to justify pre-pending the stored digits.

3.   Response to Claim Rejections

Applicant respectfully transverses the rejection of the pending claims over Yamartino and Gabara, because Yamartino and Gabara, whether considered alone or in combination, do not disclose or suggest all of the elements recited in any of Applicant's

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claims. Specifically, Yamartino and Gabara, whether considered alone or in combination, fail to disclose or suggest the claimed functional combination of (i) receiving digits entered by the user, (ii) determining whether the digits entered by the user represent an incomplete set of digits, and (iii) if the determination is that the digits entered by the user do not match digits at the end of any telephone number defined by the phone book, and automatically pre-pending a stored set of digits to the digits entered by the user so as to establish a composite telephone number.

Put simply, although both Yamartino and Gabara each teach matching a set of digits to a digit sequence so as to establish a composite telephone number, neither Yamartino nor Gabara teach the claimed function of pre-pending digits *in response to a failure of the entered digits to match digits at the end of any telephone number in the phone book.*

Yamartino teaches finding viable digits in a database and responsively prepending those digits to an entered number. Thus, Yamartino adds digits when it successfully finds information in the database, whereas Applicant's claimed invention involves adding digits upon *failure of the entered digits to match* digits at the end of any telephone number in the phone book. (The Examiner has acknowledged this deficiency of Yamartino.)

Gabara does not make up for this deficiency of Yamartino. At best, Gabara teaches adding a default area code to a dialed number in response to the exchange prefix *at the beginning of an entered 7-digit number* not matching any exchange prefix in a prefix/area code directory. However, pre-pending digits in response to a determination that digits *at the beginning of an entered number do not match* numbers in a database is

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not what is recited in Applicant claims. Applicant's claims recite pre-pending digits upon failure of the entered digits to match digits *at the end* of any number in the phone book.

Under M.P.E.P. § 2143, a *prima facie* case of obviousness of a claim over a combination of references can be established only if the references disclose or suggest every limitation of the claim. Because Yamartino and Gabara fail to teach at least the function of pre-pending digits to entered digits in response to a determination that the entered digits do not match the digits at the end of any number in the phone book, a *prima facie* obviousness of Applicant's claims over Yamartino and Gabara does not exist.

Therefore, Applicant respectfully requests favorable reconsideration and allowance of the pending claims. If the Examiner has any questions, the Examiner is invited to call the undersigned at (312) 913-2141.

Respectfully submitted,

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